

THIS DISPOSITION IS NOT CITABLE AS
PRECEDENT OF THE TTAB MAY 31, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sterling Commerce, Inc.

Serial No. 75/308,616

Stanley W. Sokoloff and Lori Boatright of Blakely,
Sokoloff, Taylor & Zafman for applicant.

Nancy L. Hankin, Senior Trademark Examining Attorney, Law
Office 106 (Mary Sparrow, Managing Attorney).

Before Seeherman, Walters and Wendel, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Sterling Commerce, Inc. has filed a trademark
application to register the mark COMMERCE:COMMUNITY for
"computer services, namely providing an interactive
computer database which enables users to access
information, facilitates the exchange of information among
users and allows users access to electronic forms,
electronic mail, database applications, administrative
tools, and information on products and ordering products

from sponsors of the web site; computer services namely providing on-line facilities for real time interaction with other computer users concerning topics relating to electronic information services; computer services namely providing an on-line bulletin board in the field of electronic information services."¹

The Trademark Examining Attorney has finally refused registration, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

As a preliminary matter, we address applicant's objections to evidence submitted by the Examining Attorney. Because the Examining Attorney has withdrawn from the record the evidence submitted with the first office action, we have not considered that evidence.

The Examining Attorney submitted, with subsequent actions, copies of third-party registrations, excerpts from the LEXIS/NEXIS and Dialog databases and pages of information downloaded from the Internet. We find this

¹ Serial No. 75/308,616, in International Class 42, filed June 13, 1997, based on an allegation of a bona fide intention to use the mark in commerce in connection with the identified services.

evidence submitted by the Examining Attorney to be properly of record and adequately identified for our consideration.

However, we also agree with the applicant's criticism of the Internet evidence and of the LEXIS/NEXIS and Dialog evidence. The Dialog excerpts are so short, some of them consisting only of phrases, that it is difficult to determine their context; the "Computer Select" information of March, 1998 from the Internet is either insufficiently identified or comprises information that appears to be from a newswire-type service; and a substantial number of the LEXIS/NEXIS and Dialog excerpts are from newswire services or foreign publications. As such, this evidence is of little probative value in determining the meaning of the terms to the average American consumer.

Additionally, we note that, except in a very few instances, none of the excerpts or third-party registrations shows the phrase "commerce community." Rather, the majority of excerpts use one term or the other and, even then, in conjunction with other terms, i.e., "electronic commerce," "Internet commerce," and "virtual community." A number of excerpts show phrases, such as "Internet commerce community."

The Examining Attorney contends that "the phrase 'commerce community' refers to individuals, organizations and other entities selling products over the Internet"; and that the phrase "is clearly descriptive of ... applicant's services, namely, putting people and businesses together for the purpose of buying and selling over the Internet."

Applicant contends that the phrase "commerce community," is not a shortened version of phrases such as "Internet commerce community"; that there is a degree of ambiguity to the phrase; and that the colon in applicant's mark, COMMERCE:COMMUNITY, creates a different commercial impression than simply the phrase "commerce community."

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that

it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

Based on the record before us, we cannot reach the conclusion argued by the Examining Attorney. Not only do we find insufficient evidence to support the conclusion that the phrase "commerce community" is merely descriptive, but we find that the colon in applicant's mark, COMMERCE:COMMUNITY, gives the mark a different commercial impression that renders it, at most, suggestive in connection with the identified services. Thus, we find that the phrase COMMERCE:COMMUNITY is not merely descriptive in connection therewith. It requires some thought to determine the nature of applicant's services or at least a feature of those services.

To the extent that our determination on this issue is not free from doubt, that doubt is resolved in applicant's behalf and the mark should be published for opposition. *See, In re Rank Organization Ltd.*, 222 USPQ 324, 326 (TTAB 1984) and cases cited therein.

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Decision: The refusal under Section 2(e)(1) of the Act is reversed.

E. J. Seeherman

C. E. Walters

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board